

REMARKS

I. Status of the Application

Claims 12-20 are pending in this application. In the November 15, 2005 office action, the examiner: (i) noted that applicant has yet to file a certified copy of the priority document; (ii) objected to the specification for various informalities; (iii) objected to the drawings as allegedly failing to comply with 37 CFR § 1.84(p)(5); (iv) rejected claims 12-20 under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim subject matter which applicant regards as the invention; (v) rejected claims 12 and 16-20 as allegedly being anticipated by U.S. Patent No. 6,239,491 to Pasch et al. (hereinafter “Pasch”); and (vi) rejected claims 13-15 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Pasch in view of U.S. Patent No. 6,830,966 to Cai et al. (hereinafter, “Cai”).

In this response, applicants have amended the specification and the claims to overcome the examiner’s objections and rejections. Applicants respectfully request reconsideration of pending claims 12-20 in view of the foregoing amendments and the following remarks.

II. A Certified Copy of the Priority Document is Enclosed

In the November 15, 2005 office action, the examiner noted that applicant has yet to file a certified copy of the 103 05 365.4 German application as required by 35 U.S.C. § 119(b). A copy of the 103 05 365.4 German application is enclosed.

III. The Objection to the Disclosure Should be Withdrawn

In the November 15, 2005 office action, the examiner objected to the disclosure for various informalities. As set forth above, applicant has amended the specification to correct the informalities. Accordingly, it is respectfully submitted that the examiner's objection to the specification should be withdrawn.

IV. The Objection to the Drawings Should be Withdrawn

In the November 15, 2005 office action, the examiner objected to the drawings as failing to comply with 37 CFR § 1.84(p)(5) for allegedly failing to include the following reference sign mentioned in the description: 319. Applicant respectfully directs the examiner's attention to Fig. 3C of the drawings, which shows reference numeral 319 on the right hand side of the broken line. Accordingly, it is respectfully submitted that the examiner's objection to the drawings should be withdrawn.

V. The Objection to the Claims and Rejection of the Claims under 35 U.S.C. § 112
Should be Withdrawn

In the November 15, 2005 office action, the examiner objected to the claims for informalities and rejected the claims under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As set forth above, applicant has amended the specification to correct the informalities and alleged indefinite limitations. Accordingly, it is respectfully submitted that the examiner's claim objections and claim rejections under 35 U.S.C. § 112, second paragraph, should be withdrawn.

VI. The Rejection of Claim 12 Under 35 U.S.C § 102 Should be Withdrawn

In the November 15, 2005 office action, the examiner rejected claim 12 under 35 U.S.C. § 102(b) as being anticipated by Pasch. As provided in MPEP § 2131, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). In addition, the elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Pasch reference does not disclose all the limitations of amended claim 12. For example, the Pasch reference does not disclose “a first insulating layer ... wherein a part of the first insulating layer is arranged between the first and the second terminal”. An example of this limitation is shown in Fig. 2H of the present application. Pasch does not disclose this limitation. The insulating layer 150 in Pasch (which the examiner regards as the first insulating layer) is clearly not arranged between the terminals, as required by claim 14. While a part of the insulating layer 130 in Pasch might be considered to be arranged between the terminals (which the examiner regards as first terminal 14 and second terminal 132), the insulating layer 130 does not have “an insulation-layer surface ... located at a longer distance from the substrate surface than the second terminal” as required by claim 12. Accordingly, the insulating layer 130 can not be considered the first insulating layer as defined by claim 12. Thus, Pasch does not disclose the limitation of claim 12 of “a first insulating layer ... wherein a part of the first

insulating layer is arranged between the first and the second terminal".

As another example, the Pasch reference does not disclose the limitation in claim 12 of a "second conductive material contact[ing] the first conductive material on a top surface and on a portion of a side surface thereof". Pasch is completely silent concerning this limitation.

For at least the reasons discussed above, Pasch does not disclose all limitations of claim 12 of the present application. Accordingly, it is respectfully submitted that claim 12 is allowable and the examiner's rejection of claim 12 as anticipated by Pasch under 35 U.S.C. § 102(b) should be withdrawn.

VII. The Rejection of Claims 13-20 under 35 U.S.C. § 102 and § 103 Should be Withdrawn

Dependent claims 13-20 depend from and incorporate all the limitations of allowable independent claim 12. Accordingly, it is respectfully submitted that dependent claims 13-20 are also allowable for at least the same reasons that independent claim 12 is allowable, as well as additional reasons.

VIII. An Information Disclosure Statement is Enclosed

Applicant submits herewith an information disclosure statement pursuant to 37 CFR § 1.97(c). The references contained in the enclosed information disclosure statement were first cited in a communication from a foreign patent office in the priority German application. Applicant has enclosed a check in the amount of \$180.00 in payment of the fee for the information disclosure statement as set forth in 37 CFR §

1.97(c) and 37 CFR § 1.17(p).

IX. Conclusion

For all of the foregoing reasons, it is respectfully submitted the applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this application is therefore respectfully requested.

In the event applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, the applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 13-0014.

Respectfully submitted,



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